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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/817,387

03 26 2001

Eckart Matthes

101195-24

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09 19 2002

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EXAMINER

EPPS, JANET L.

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 09 19 2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,387

Applicant(s)

MATTHES ET AL

Examiner

Janet Epps

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to chimeric oligonucleotides of general formula I, classified in class 536, subclass 24.5.
 - II. Claim 7, drawn to a method of inhibiting telomerase activity, classified in class 435, subclass 375.
 - III. Claim 8, drawn to a method of *in vivo* treatment of tumors, classified in class 514, subclass 44.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the chimeric oligonucleotides of invention I can be used in a method for detecting the presence of telomerase in a sample.
3. Inventions II and III are distinct methods since they are drawn to distinct methods comprising different method steps and different objectives. Invention II is drawn to a method of inhibiting telomerase activity in a tumor cell line, and Invention III is drawn to an *in vivo* method of treating tumors.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Sequence Restriction

6. Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the chimeric oligonucleotide sequences listed in claim 6 are subject to restriction. As per M.P.E.P. 2434, "the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, in most cases, up to 10 independent and distinct nucleotide sequences will be examined in a single application without restriction. Those sequences which are patentably indistinct from the sequences selected by the applicant will also be examined."

7. Claim 6 specifically claims SEQ ID NOS 1-29. Although the chimeric oligonucleotide sequences claimed, each target and inhibit expression of the same gene, the instant chimeric oligonucleotide sequences are considered to be unrelated, since each chimeric oligonucleotide sequence claimed is structurally and functionally independent and distinct for the following reasons: each chimeric oligonucleotide sequence has a unique nucleotide sequence and structure, and due to the variations in modifications of the chimeric oligonucleotides according to SEQ ID

NO: 1-29, each chimeric oligonucleotide sequence interacts with the DNA binding regions of the telomerase enzyme in a unique manner.

8. Furthermore, a search of more than one (1) of the chimeric oligonucleotide sequence claimed in claim 6 presents an undue burden on the Patent and Trademark Office due time limitations of the sequence search facilities, the growing size of the nucleotide databases, the complex nature of the search and the corresponding examination of more than one (1) of the claimed chimeric oligonucleotide sequences. In view of the foregoing, one (1) chimeric oligonucleotide sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1) chimeric oligonucleotide sequence from claim 6.

9. Applicant is advised that the reply to this requirement to be complete must include an election of an invention according to inventions I-III, and an election of an invention according to SEQ ID NO: 1-29, to be examined even though the requirement be traversed (37 CFR 1.143).


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L Epps, Ph.D. whose telephone number is 703-308-8883.

The examiner can normally be reached on M-T, Thurs-Friday 9:00AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703)-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-746-5143 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Janet L Epps-Ford, Ph.D.
Examiner
Art Unit 1635

JLE

September 18, 2002